UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,356	07/13/2001	Yuichiro Deguchi	SONI-6300	3812

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EXAMINER
BACKER, FIRMIN

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/905,356	DEGUCHI, YUICHIRO
	Examiner	Art Unit	
	Firmin Backer	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 July 2001*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-47* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1)☒ Notice of References Cited (PTO-892) 4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)☐ Notice of Informal Patent Application (PTO-152)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . 6)☐ Other: .

U.S. Patent and Trademark Office
PTOL-326 (Rev. 11-03) Office Action Summary Part of Paper No. 4

DETAILED ACTION

This is in response to a letter for patent filed on July 13th, 2001 in which claims 1-47 are

presented for examination. Claims 1-47 are pending in the letter.

Claim Objections

1.   Claim 11 is objected to because of the following informalities: Applicant discloses "the

system of claim ". Appropriate correction is required.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

3.   Claim 40 is rejected under 35 U.S.C. 101 because the claimed invention is directed to

non-statutory subject matter. .

The basis of this rejection is set forth in a two prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete and tangible result.

For a claimed to be statutory, the claimed invention must be within the technological arts.

Mere ideas in the abstract (i.e., abstract idea law of nature, natural phenomena) that do not apply,

involve, use, or advance the technological arts fail to promote the "progress of science and the

useful arts" and therefore are found to be non-statutory subject matter. For a method claim to

pass the muster, the recited method must somehow apply, involve, use, or advance the

technological arts.

In the present case the inventive concept in claim 40 only recites an abstract idea. The

recited method of purchasing a data marking device from a vendor, marking one or more

broadcast data etc. do not apply, involve, use or advance the technological arts since all the steps

can be performed in the mind of the user or by use of pencil and paper and no specific

technology (e.g. computer, processor) is expressly recited in the body of the claims. *In re Toma*

(CCPA 197 USPQ 852 (1978)).

Although the recited method produces a useful, concrete and tangible result, since the

claimed invention, as a whole, it not within the technological arts as explained above, claim 40

deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Rhoads et al

(U.S. PG Pub. No 2002/0012403).

6.   As per claims 1, Rhoads et al teach vendor tracking system for use with a data marking

device, comprising: a data network (*network fig 1)* a user terminal (*user device, 10)* coupled to

the data network configured to transmit a signal including information corresponding to marked

data (*see figs 4, 5)* a vendor terminal (*server, local application)* configured to transmit (*extract*

and communicate) a vendor identification code (*code identifier to identifies distributor) (see figs*

7-9, paragraphs 0118-0123); a server terminal coupled to the data network configured to receive

the signal from the user terminal and the vendor identification code, the server terminal further

configured to transmit information corresponding to the vendor identification code and the

received signal to the user terminal (*see figs 7-9, paragraphs 0118-0123)*.

7.   As per claims 2, Rhoads et al teach vendor tracking system wherein the signal

corresponding to the marked data includes one or more of a time information a date information,

and a user identification information (*see figs 7-9, paragraphs 0118-0123)*.

8.   As per claims 3, Rhoads et al teach vendor tracking system further including a data

marking device configured to transmit information corresponding to the marked data and data

marking device identification code (*see figs 7-9, paragraphs 0118-0123)*.

9.   As per claims 4, Rhoads et al teach vendor tracking system wherein the data marking

device identification code is a predetermined length numeric sequence, a predetermined length

letter sequence, and a predetermined length combination of numeric and letter sequence *(see figs*

7-9, paragraphs 0118-0123).

10.   As per claims 5, Rhoads et al teach vendor tracking system wherein the marked data

corresponds to one of a radio broadcast music clip, a television broadcast music clip, and a web-

cast broadcast music clip *(see paragraphs 0020-0039).*

11.   As per claims 6, Rhoads et al teach vendor tracking system wherein the data marking

device includes an electronic music marker *(see paragraphs 0020-0039).*

12.   As per claims 7, Rhoads et al teach vendor tracking system wherein the user terminal

includes one of a personal computer, an internet access enabled personal digital assistant, a

Wireless Application Protocol enabled mobile telephone, and an i-mode enabled mobile

telephone *(see figs 1, 2, 3).*

13.   As per claims 8, Rhoads et al teach vendor tracking system wherein the data network

includes one of a Local Area Network (LAN), a Wide Area Network (WAN), and an internet

connection *(see paragraphs 0020-0039).*

14.   As per claims 9, Rhoads et al teach vendor tracking system wherein the user terminal and the server terminal are coupled to the data network using one of a TCP/IP protocol and a wireless application protocol (*see paragraphs 0020-0039*).

15.   As per claims 10, Rhoads et al teach vendor tracking system wherein the vendor terminal is coupled to the data network (*see figs 1, 2, 3*).

16.   As per claims 11, Rhoads et al teach vendor tracking system wherein the user terminal includes an output unit, the output unit configured to display information received from the server terminal (*see paragraphs 0020-0039*).

17.   As per claims 12, Rhoads et al teach vendor tracking system wherein the displayed information includes a vendor sales information corresponding to the purchase of a product for the marked data from a store related to the vendor terminal (*see paragraphs 0020-0039*).

18.   As per claims 13, Rhoads et al teach vendor tracking system wherein the store includes one of a retail store of the vendor terminal and an online store of the vendor terminal (*see paragraphs 0020-0039*).

19.   As per claims 14, Rhoads et al teach vendor tracking system wherein the vendor sales information displayed on the display unit of the user terminal includes a telephone number of the store, a hypertext link for the store, a facsimile number of the store, an email address of the store,

a price information for the purchase of the product, and a delivery information for the delivery of

the product *(see paragraphs 0020-0039).*

20.   As per claims 15, Rhoads et al teach vendor tracking system wherein marked data

includes information corresponding to a broadcast music clip, and further, wherein the product

includes one or more of a CD, a video tape, an audio cassette corresponding to the broadcast

music clip *(see paragraphs 0020-0039).*

21.   As per claims 16, Rhoads et al teach vendor tracking system wherein the server terminal

includes a storage unit for storing the vendor identification code received from the vendor

terminal and the received signal from the user terminal *(see paragraphs 0020-0039).*

22.   As per claims 17, Rhoads et al teach vendor tracking system wherein the vendor terminal

is further configured to transmit one or more of a purchased product identification code, the one

or more of the purchased product identification code corresponding to the transmitted signal

from the user terminal *(see paragraphs 0020-0039).*

23.   As per claims 18, Rhoads et al teach vendor tracking system wherein each of the one or

more of the purchased product identification code is unique *(see figs 7-9, paragraphs 0118-*

0123).

24.   As per claims 19, Rhoads et al teach vendor tracking system further including a playlist

provider configured to transmit to the server terminal information related to the data broadcast

from a radio or a television station corresponding to marked data *(see figs 7-9, paragraphs 0118-*

0123).

25.   As per claims 20, Rhoads et al teach vendor tracking system wherein the playlist provider

is coupled to the data network *(see figs 1, 2, 3)*.

26.   As per claims 21, Rhoads et al teach vendor tracking system for use with a music marker

device *(see figs 4, 5)*, comprising: a data network *(network fig 1)*; a music marker device

(embedded process, (see figs 1, 2, 3) configured to store information corresponding to one or

more of a music broadcast, a user terminal *(user device, 10)* coupled to the marker device, the

user terminal configured to receive the stored information corresponding to the one or more of a

music broadcast from the marker device and an identification code corresponding to the marker

device for transmission over the data network *(see figs 1, 2, 3)* a vendor terminal *(distributor)*

configured to transmit a vendor identification code *(distributor ID)* and one or more of purchased

marker device identification codes corresponding to the vendor identification code *(see*

paragraphs 0020-0039); a server terminal *(server)* coupled to the data network configured to

receive the information corresponding to the one or more of the music broadcast and the marker

device identification code from the user terminal *(see figs 4, 5)*, and the vendor identification

code and the one or more the purchased marker device identification codes corresponding to the

vendor identification code, the server terminal further configured to compare the identification

code received from the user terminal with the one or more of the identification codes received

from the vendor terminal, and accordingly, to transmit information to the user terminal based on

the comparison *(see figs 7-9, paragraphs 0118-0123)*.

27.   As per claims 22, Rhoads et al teach vendor tracking system wherein the stored

information corresponding to the one or more broadcast music includes one or more of a time

information corresponding to the music broadcast a date information corresponding to the music

broadcast and a geographic information corresponding to the music broadcast *(see figs 1, 2, 3)*.

28.   As per claims 23, Rhoads et al teach vendor tracking system wherein each of the one or

more of the purchased marker device identification codes is a unique predetermined length

numeric sequence, a unique predetermined length letter sequence, and a unique predetermined

length combination of numeric and letter sequence *(see paragraphs 0020-0039)*.

29.   As per claims 24, Rhoads et al teach vendor tracking system wherein the information

transmitted from the server terminal to the user terminal includes one or more of a name of the

broadcast music, a name of the artist of the broadcast music, a name of the music album *(see

paragraphs 0020-0039)*.

30.   As per claims 25, Rhoads et al teach vendor tracking system wherein the information

transmitted from the server terminal to the user terminal further includes purchase information

for the purchase of the broadcast music *(see paragraphs 0020-0039)*.

31.   As per claims 26, Rhoads et al teach vendor tracking system wherein the purchase

information includes information corresponding to a store of the vendor terminal (*see*

paragraphs 0020-0039).

32.   As per claims 27, Rhoads et al teach vendor tracking system wherein the information

corresponding to the store includes a hypertext link to an online retail store of the vendor

terminal.

33.   As per claims 28, Rhoads et al teach vendor tracking system wherein the purchase

information includes one or more of cost information for the purchase the broadcast music

album, shipping information for the delivery of the broadcast music album purchase, and a

payment type information for the purchase of the broadcast music album purchase *(see figs 7-9,*

paragraphs 0118-0123).

34.   As per claims 29, Rhoads et al teach vendor tracking system wherein the information

transmitted from the server terminal to the user terminal is displayed on a display unit of the user

terminal as one or more of a two-dimensional image, a three-dimensional still image, a dynamic

video image, and a text data *(see figs 7-9, paragraphs 0118-0123).*

35.   As per claims 30, Rhoads et al teach vendor tracking system wherein the user terminal

includes one of a personal computer, an internet access enabled personal digital assistant, a

Wireless Application Protocol enabled mobile telephone, and an i-mode enabled mobile

telephone *(see paragraphs 0020-0039)*.

36.   As per claims 31, Rhoads et al teach vendor tracking system wherein the data network

includes one of a Local Area Network (LAN), a Wide Area Network (WAN), an internet

connection, and a wireless data exchange network *(see paragraphs 0020-0039)*.

37.   As per claims 32, Rhoads et al teach vendor tracking system wherein the user terminal

and the server terminal are coupled to the data network using one of a TCP/IP protocol, and a

wireless application protocol *(see paragraphs 0020-0039)*.

38.   As per claims 33, Rhoads et al teach a method comprising receiving a vendor

identification code and one or more data marking device identification code corresponding to the

vendor identification code; receiving one or more marked data and a corresponding data marking

device identification code; comparing the data marking device identification code corresponding

to the vendor identification code with the data marking device identification code corresponding

to the one or more marked data; and transmitting purchase information related to the marked data

from a vendor corresponding to the received vendor identification code based on the comparing

step *(see figs 7-9, paragraphs 0020-0039, 0118-0123)*.

39.   As per claims 34, Rhoads et al teach a method further including displaying the

transmitted purchase information *(see paragraphs 0020-0039)*.

40.   As per claims 35, Rhoads et al teach a method further including storing the received

vendor identification code and the data marking device identification code corresponding to the

vendor identification code *(see paragraphs 0020-0039)*.

41.   As per claims 36, Rhoads et al teach a method further including storing the received one

or more marked data and the corresponding data marking device identification code *(see

paragraphs 0020-0039)*.

42.   As per claims 37, Rhoads et al teach a method further including updating the stored one

or more data marking device identification code corresponding to the received vendor

identification code and the stored data marking device identification code corresponding to the

received marked data *(see figs 7-9, paragraphs 0118-0123)*.

43.   As per claims 38, Rhoads et al teach a method wherein each of the one or more data

marking device identification code is unique *(see paragraphs 0020-0039)*.

44.   As per claims 39, Rhoads et al teach a method wherein the data marking device

identification code corresponding to the vendor identification code and the data marking device

identification code corresponding to the marked data are the same *(see paragraphs 0020-0039)*.

45.   As per claims 40, Rhoads et al teach a method comprising purchasing a data marking

device from a vendor; marking one or more broadcast data (*embedding process, figs 1, 2*)

communicating (*linking*) with a data marking device service provider (*distributor*) (*see fig 2*);

receiving purchase information (*offer link sale*) corresponding to the marked one or more

broadcast data for purchase from the vendor (*see fig 2*) (*see paragraphs 0020-0039*).

46.   As per claims 41, Rhoads et al teach a method wherein the data marking device includes

an electronic music marker device (*see paragraphs 0020-0039*).

47.   As per claims 42, Rhoads et al teach a method wherein the one or more broadcast data

includes one or more radio broadcast music clip, a television broadcast music clip and a web-cast

broadcast music clip (*see paragraphs 0020-0039*).

48.   As per claims 43, Rhoads et al teach a method wherein the communicating includes:

connecting to a gateway device; and accessing a user account in a web domain of the service

provider (*see paragraphs 0020-0039*).

49.   As per claims 44, Rhoads et al teach a method wherein the gateway device includes one

or more of a personal computer, an internet access enabled personal digital assistant, a Wireless

Application Protocol enabled mobile telephone, and an i-mode enabled mobile telephone (*see

paragraphs 0020-0039*).

50.   As per claims 45, Rhoads et al teach a method wherein the received purchase information

includes a purchase price of a music album corresponding to the marked broadcast data from the

vendor *(see paragraphs 0020-0039)*.

51.   As per claims 46, Rhoads et al teach a method wherein the communicating includes

establishing a connection with a data network under one of a TCP/IP protocol, and a wireless

application protocol *(see paragraphs 0020-0039)*.

52.   As per claims 47, Rhoads et al teach a vendor tracking system for use with a data

marking device, comprising: means for receiving a vendor identification code and one or more

data marking device identification code corresponding to the vendor identification code; means

for receiving one or more marked data and a corresponding data marking device identification

code; means for comparing the data marking device identification code corresponding to the

vendor identification code with the data marking device identification code corresponding to the

one or more marked data; and means for transmitting purchase information related to the marked

data from a vendor corresponding to the received vendor identification code based on the

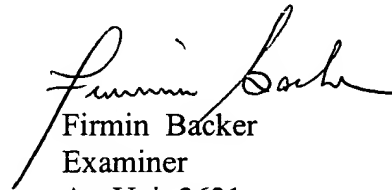comparing means *(see figs 7-9, paragraphs 0020-0039, 0118-0123)*.

Conclusion

53.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. *(see form 892)*.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

/Firmin Backer
Examiner
Art Unit 3621

November 9, 2003